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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,510	01/06/2004	Robert W. Jones	14991.01	3347

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EXAMINER
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DRODGE, JOSEPH W

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/751,510

Applicant(s)

JONES, ROBERT W.

Examiner

Joseph W. Drodge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

The Declaration filed on May 1, 2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Groth et al reference.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Groth reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). The gutter foam filter insert shown as Exhibit B of the Declaration fails to show the critical claimed feature of a filter insert having a flat, angled side that is configured to leave a triangular-shaped insert at the bottom and front wall of a gutter, instead showing a foam filter substantially filling a gutter that is characteristic of older prior art. Accordingly the features demonstrated by the Declaration are not commensurate with critical aspects of the Instant Claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 12,13,15-17,19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan patent 3,855,132 in view of Groth et al patent 6,932,911 (having an effective filing date of February 18, 2003 based on provisional application 60/448,082), newly cited. It is noted that 2/18/03 is prior to the critical March 2003 date noted in Applicant's recently filed Affidavit. Dugan discloses a foam filter insert 2, of open cell foam material (Abstract and column 2, lines 21-26), combined with a gutter 5 having all of the cross-sectional features of filter insert and gutter of the instant claims, including angled or triangular sides 7 between front edge of outer portion of upper side and lower side that is forward of rear edge of lower side, so as to generally correspond to the generally triangular shape of outer surface of the corresponding gutter, while leaving some void space between filter insert and lower and outer sides of the gutter (see especially figure 1 and column 1, lines 56-60).

Dugan, in each of the figure 1 and figure 2 embodiments, disclose the filter insert having a generally horizontal upper side 6 (see column 2, lines 5-7), generally vertical rear side 5 that is perpendicular to the upper side and bearing against the rear side of the gutter, and a lower side parallel with the upper side, and bearing against the gutter lower wall in the figure 1 embodiment, and a planar, or generally flat angled side extending downwardly and inwardly towards the lower filter insert side from the front

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edge of the upper side of the filter insert, such front edge being adjacent the gutter front wall upper lip. The general form of the filter insert of Dugan approximates a combination of an upper truncated right triangular prism with a lower rectangular prism.

In the figure 1 embodiment, a filter insert configuration that allows free flow of liquid is provided by way of forming the filler with a pre-cut slot on its lower side or manufacturing it to not extend all the way to the gutter bottom while being supported by spaced supports 7 (see column 2, lines 9-20).

In the figure 2 embodiment, the filter insert is configured and manufactured to essentially fill the entire inner volume of the gutter. It is stated that the filter insert may either be manufactured to be cut to the gutter shape or alternatively, be cut to a larger size and compressed to fit the trough of the gutter.

The claims differ in requiring the insert to have the overall form of a truncated right triangle, where the angled side extends all the way downwardly and inwardly to a forward edge of the lower side of the gutter insert, and such as to leave a void having a substantially triangular-shaped cross section between the bottom and front walls of the gutter and the angled side of the insert.

Groth et al teach such outer angled surface of a filter insert 20 extending all the way from upper side of the filter insert adjacent upper lip of the gutter to the lower side of the filter insert and imparting a general form of a truncated right triangle for the elongated filter insert. This feature is clearly shown as leaving the instantly claimed triangularly shaped void between bottom and outer walls of gutter and angled surface 26 of filter insert (figure 2 and column 5, lines 28-44). Alternatively, the embodiment of

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figure 4 shows angled surface 226/227 of the filter insert more closely aligned with the outer gutter wall, with their being one or more void spaces 215 in the lower or outer surface of the filter insert (also see column 5, line 64-column 6, line 12 of the Groth patent and figure 4 and page 7 (Second Embodiment) of the Groth provisional application. This alternative embodiment also imparts the general form of a truncated right triangle to the filter insert. For the alternative embodiment, one of ordinary skill would obviously envision the option of a void space 215 being formed at the juncture of bottom wall and outer angled wall of the filter insert giving a generally triangular shaped void as instantly claimed. ***Also, the first embodiment of the Provisional Application at page 5, 1<sup>st</sup> full paragraph and figure 1 teach the claimed flat and angled side of gutter filter insert, inherently leaving a triangle-shaped void space proximate lower and outer walls of the gutter.***

It would have been obvious to one of ordinary skill in the art to have manufactured the filter insert of Dugan to contain such angled side taught by Groth et al, in order to better fit the insert into gutters having an angled outer wall, gutters conventionally having such angled outer wall to facilitate ease and quickness of installation of the filter insert into the gutter by the homeowner, and/or to achieve secure fitting of the filter insert within the gutter to give form and solidity to the gutter, and while also enabling free flow of runoff water during relatively heavy rainfall events (see column 4, lines 5-27 of Groth).

As to claim 16, figure 1 also shows a gutter inner lip portion extending downward and then inward

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For claim 17, figure 1 also illustrates the gutter and filter insert being located below the draining eave of 4 of a roof.

Regarding claim 13, requiring foam material to have 10 to 20 cells per square inch, such limitation is taught by Dugan at column 2, lines 36-38.

Regarding claims 15 and 19, Dugan teaches a gutter filter insert with four foot lengths of foam at column 2, lines 27-34.

For claim 20, Dugan also discloses the filter insert being readily placed or fitted into the trough of gutter walls (column 1, lines 56-60 and 26-28, hence also removable from the gutter

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Groth et al as applied to claims 12 and 13 and further in view of Etani patent 3,946,362 of record. Claim 14 specifies polyether foam, Dugan teaching polyurethane foam and Etani teaching that polyether foam is a component of polyurethane foam filters. It would have been obvious to have utilized polyether or polyurethane foam for the filter insert of Dugan, as taught by Etani, since these materials are readily available and easily manufactured and processed.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dugan in view of Groth et al as applied to claims 12 and 13 and further in view of Hunt patent 5,103,601 of record. Claim 18 differs in requiring gutter spikes extending through the gutter upper lip to secure gutter to building structure. It would have been further obvious to one of ordinary skill in the art to have utilized the spikes of Hunt in the installation of

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gutter and insert of Dugan, in order to firmly secure gutter to building so that it does not fall off.

Applicant's arguments filed on May 1, 2006 have been fully considered but they are not persuasive. It is argued that the rejection of the claims based on teachings of the patent to Groth et al are overcome in view of the May 1, 2006 submitted Declaration. However, such Declaration has been shown to be insufficient. It is submitted that The gutter foam filter insert shown as Exhibit B of the Declaration fails to show the critical claimed feature of a filter insert having a flat, angled side that is configured to leave a triangular-shaped insert at the bottom and front wall of a gutter, instead showing a foam filter substantially filling a gutter that is characteristic of older prior art. Accordingly the features demonstrated by the Declaration are not commensurate with critical aspects of the Instant Claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Drodge at telephone number 571-272-1140. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at 571-272-1151. The fax phone number for the examining group where this application is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or Public PAIR, and through Private PAIR only for unpublished applications. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JWD

May 15, 2006

  
JOSEPH DRODGE  
PRIMARY EXAMINER